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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,915	08/21/2003	John Joseph Lawlor	Q77116	6479
23373	7590	09/20/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/644,915	LAWLOR ET AL.	
	Examiner	Art Unit	
	David T. Fidei	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 40-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/21/03</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed August 21, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.
2. The information disclosure statement filed August 21, 2003 also fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 40-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 40, 44 and 46, a “dosed” position is set forth that is indefinite.

In claims 40-59 an as sundry of means is recited where it is unclear to the Examiner if applicant is invoking 35 U.S.C. 112, sixth paragraph. For example; in claim 43 a “lower support means” is recited for supporting the disc thereon, and an upper “retaining means” spaced apart from the lower support means and co-operating with the lower support means for defining the

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disc accommodating means and for retaining the disc in the disc accommodating means against movement of the disc perpendicularly to the storing plane where it not entirely clear what the scope of the claim is.

Applicant must identify every means plus function involved in the claims with a concise explanation of the subject matter defined, referring the to specification by page number and line, and to the drawings, and set for the structure, material, or acts described in the specification corresponding to each claimed function with referent to the specification by page and line number, and to the drawing. This is done to establish the prosecution history in accordance with 37 CFR 41.37(c)(1)(v).

In claims 45, 54 and 57, the narrative makes it unclear if applicant's intent is to set forth the subject matter followed by the optional language of "preferably" and "advantageously".

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 40-42, 45, 52, 53 and 55-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Oland (Patent no. 5,704,474). A storage case is disclosed comprising an outer shell (1), and an inner carrier (2), a disc accommodating means (15) for receiving and storing a disc (30) therein with the disc defining a storing plane. The inner carrier being slideable in the outer shell between a closed position within the outer shell and an open position extending outwardly of the outer shell for

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providing access to the disc accommodating means (15), and a securing means (33) in the inner carrier for securing the disc in the disc accommodating means (15), characterized in that a guide means (29, 36) is provided in the inner carrier for slideably guiding the disc into and out of the disc accommodating means (15), and the securing means secures the disc in the storing plane in the disc accommodating means against sliding movement in the storing plane through the guide means (25, 36).<sup>1</sup>

As to claim 41, the securing means is located adjacent the disc accommodating means (base plate 15) and extends inwardly thereto for releaseably securing the disc in the disc accommodating means (15) against sliding movement through the guide means.

As to claim 42, the outer shell (1) co-operates with the inner carrier for enclosing the disc accommodating means when the inner carrier is in the closed position, note figure 1.

As to claim 45, the outer shell (1) comprises a top plate (3) and a pair of spaced apart elongated side walls (4) extending downwardly from the top plate (3) for co-operating with the inner carrier for enclosing the disc accommodating means (20).

As to claim 52, locating means (8) is provided on the outer shell for co-operating with an outer shell of an adjacent storing case for accommodating stacking of the storage case with the other storage case, one above the other, see figure 1.

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<sup>1</sup> In determining anticipation as established above, the examiner finds that the prior art element performs the function specified in the claim, and is not excluded by any definition provided in the specification for an equivalent. Therefore, it is inferred from that finding that the prior art element is an equivalent, and the claimed limitation is anticipated by the prior art element. As such, the burden shifts to applicant to show that any aforementioned equivalent element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983).

If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification. Such reasons may include, but are not limited to: 1) teachings in the specification that particular prior art is not equivalent, 2) teachings in the prior art reference itself that may tend to show non-equivalence, or 3) Rule 132 affidavit evidence of facts tending to show non-equivalence.

Moreover, if an applicant argues that the "means" or "step" plus function language in a claim is limited to certain specific structural or additional functional characteristics (as opposed to "equivalents" thereof) where the specification does not describe the invention as being only those specific characteristics, the claim should be not allowed until the claim is amended to recite those specific structural or additional functional characteristics (emphasis added). See 1162 OG 61, May 17, 1994.

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As to claim 53, that the locating means comprises one of a first male (8) and female (9) locating means mounted on one of a side or end of the outer shell for co-operating with a corresponding other of a first male or female locating means on the outer shell of the other storage case.

As to claim 55, the inner carrier and the outer shell manifestly defines a label receiving means in as much as is claimed.

As to claim 56, the lower support means has no antecedent basis.

As to claim 57, the disc accommodating means (15) is a disc storing area, and the preferably language is of no patentable significance.

As to claim 58, a first grip means (40) is provided for releasably engaging and retaining the inner carrier in the closed position in the outer shell (4).

As to claim 59, a second grip has no antecedent basis from claim 40 and is also provided by 40.

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oland (Patent no. 5,704,474). Oland (Patent no. 5,704,474) discloses the claimed invention except for locating means extends upwardly from the top plate (3) of the outer shell. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the locating means extends upwardly from the top plate (3) of the outer shell, rather than downward, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

**REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION**

9. “In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)”, see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner’s action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based


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on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
September 18, 2005